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SR

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/110,987 07/07/98 GOCHANOUR

G GGG-10003/29

EXAMINER

QM22/0330

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ART UNIT

PAPER NUMBER

3724

DATE MAILED:

03/30/01

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/110,987

Applicant(s)

GOCHANOUR, G. GARY

Examiner

Kim Tran

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 January 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-3 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 10-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3, 5, 6 and 8 is/are rejected.
- 7) ☐ Claim(s) 7, 9 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

1. Upon further consideration and review, the Examiner has withdrawn the previous office action, paper no. 9. The following is an a new office action addressing claims 1-3 and 5-9 as amended on January 24, 2000.

Election/Restrictions

2. In response to Applicant's traverse of the Restriction requirement, the Examiner has deemed that it is proper as stated in office action paper no. 6 and therefore FINAL. If the Applicant continues to traverse the Restriction requirement, he may submit a petition under 37 CFR §1.144.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 3 and 8, it is unclear how defining the workpiece further defines the claimed invention.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5-6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garr '774 in view of Stoller. Garr '774 discloses the invention substantially as claimed including a housing to receive a roll of partially transparent flexible film (figure 1), edge operative to separate the roll of film (46), base member defining an area to permit placement of the palm surface of an adult hand (17), and an aperture through which the film is pulled and drawn off the roll (19), and non-resilient material (col. 5, lines 33-37). Garr '774 does not teach a resilient base member that is at least 40 square inches or flexible film with perforations.

However, Stoller teaches a dispenser that dispense perforated flexible film (fig. 1, 28). In view of Stoller, it would have been obvious to one of ordinary skill in the art to provide the apparatus of Garr '774 to dispense perforated flexible film because the perforations assist in the separation mechanism when the film is drawn against an edge.

Garr '774 discloses the claimed invention except for a base that is at least 40 square inches. It would have been an obvious matter of design choice to provide a base that is at least 40 square inches in order to accommodate large rolls of plastic film, since such a modification would have involved a mere change in the size of a

component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Garr '774 discloses the claimed invention except for the resilient base member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a resilient material base member, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Amendment

7. Applicant's arguments have been fully considered but they are not persuasive.

In response to applicant's argument that Garr '774 is dangerous to the intended use of the claimed invention, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that Garr '774 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant

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was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Garr '774 and the Applicant's invention are both pertinent to the same particular problem, dispensing and separating a flexible film. The Examiner disagrees with the Applicant's contention that Garr '774 is non-analogous in both structure and function. The structure is obvious in Garr '774; a housing that supports a roll of plastic flexible film, edge to separate the film, and base that enables a person to place a hand on the flexible film in order to draw the film from the housing to the edge. The function of both Garr '774 and the claimed invention is to dispense flexible film from a housing and separating the film along an edge.

For the reasons above, the rejection is deemed proper.

Allowable Subject Matter

8. Claims 7 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Tran whose telephone number is 703-305-2597.

The examiner can normally be reached on Monday through Friday from 8-5:30 pm.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 703-308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-2597 for regular communications and 703-305-9835 for After Final communications.

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



knt
March 28, 2001



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700